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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/724,496	11/28/2000	Zaid Joyyosi	02481.1691-00	6965

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EXAMINER

LIU, HONG

ART UNIT

PAPER NUMBER

1624

DATE MAILED: 11/18/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/724,496

Applicant(s)

Jayyosi et al.

Examiner

First Last

Art Unit

1234

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_\_
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-94 is/are pending in the application.
- 4a) Of the above, claim(s) 3-6, 8, 10-13, 16-19, 22, 24-26, 28-38, 40-48, 50 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 94 is/are allowed.
- 6) ☒ Claim(s) 1, 2, 7, 9, 14, 15, 20, 21, 23, 27, 39, 49, and 89 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 6 6) ☐ Other: \_\_\_\_\_

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### **DETAILED ACTION**

Claims 1-94 are pending in this application.

#### ***Election/Restriction***

Applicants' election of the species of Example 7z with traverse in Paper No. 9 is noted. However, the traverse is not found to be persuasive. Applicants' compounds embraced by different ring structures constitute structurally dissimilar compounds. Placing all such compounds into the same claim is repugnant to scientific classification as they are separately classified and require separate literature searches. As indicated in the previous office action, depending on the definition of Ar I, Ar II, and Ar III, the compounds can be classified in different classes and subclasses. To search all the patents under these classes and subclasses would place a substantial burden on the examiner, let alone search of other non-patent literature. Having a common utility among the groups is not enough where as herein there is not a substantial structure feature common to all groups. They are made and used independently of each other, are not art-recognized equivalents. Such traverse of the restriction requirement is not consistent with applicants' urging of patentability over the art cited below which is much closer to some of the claimed compounds than they in turn are to each other. The compounds of US 5,051,427 which render the compounds wherein Ar I is quinoline obvious would not have rendered obvious the compounds wherein Ar I, for instance, is oxazole.

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Applicants are also advised of MPEP 803.02, Restriction -Markush Claims[R-2], forth paragraph, where is stated;

“As an example, in the case of an application with a Markush -type claims drawn to the compound C-R, wherein R is a radical selected from the group consisting of A, B, C, D, and E, the examiner may require a provisional election of a single species, CA, CB, CC, CD, or CE. The Markush-type claim would then be examined fully with respect to the elected species and any species and any species considered to be clearly unpatentable over the elected species. If on examination the elected species is found to be anticipated or rendered obvious by prior art, the Markush-type claim and claims to the elected species shall be rejected, and claims to the non-elected species would be held withdrawn from further consideration. As in the prevailing practice, **a second action on the rejected claims would be made final.**” (Emphasis added).

The elected compound was not found in the search and the search was expanded to compounds wherein Ar I is a fused arylheterocyclyl. Because prior art was found for this subgenus, the Markush-type claims that recite these species were rejected. According to MPEP 803.02 cited above, claims 3-6, 8, 10-13, 16-19, 22, 24-26, 28-38, 40-48, 50-88 and 90-93 which are directed to non-elected species were held withdrawn from further consideration.

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***Specification***

The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States

1. Claim 1, 2, 7, 9, 14, 15, 20, 21, 23, 27, 39, 49, 89 are rejected under 35 U.S.C. 102(b) as being anticipated by Huang et al. (US 5,051,427). Huang teaches the compounds and composition of the instant invention (see, for example, compounds in Table III, col. 14).

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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Claims 1, 2, 27, and 49 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The following reasons apply:


3. 1). "Optionally substituted" throughout the claims is unclear as to the nature and number of substituent(s) intended.
4. 2). The use of "heterocyclyl," "heteroaryalkyl" in the definition of variables is unclear to the array of heteroatoms, size of the rings, as well as nature of atoms as ring members. See In re Wiggins 179 USPQ 421 for certain terminology regarding heterocyclic ring systems.
- 5.

*Allowable Subject Matter*

Claim 94 is allowable. None of the prior art of record nor a search in the pertinent art area teaches the exact species..

6. Any inquiry concerning this communication should be directed to Examiner Hong Liu whose telephone number is (703) 306-5814. The examiner can normally be reached on Monday through Friday from 8:30 AM to 6:00 PM. If attempts to reach the examiner by the phone are unsuccessful, the examiner's supervisor, Mukund Shah can be reached at (703) 308-4716. The fax phone number for this group is (703) 308-4734 for "unofficial" purposes and the actual number for **official** business is (703) 308-4556. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose number is (703) 308-1235.

hl  
November 15, 2002

  
**Mukund Shah**  
**Supervisory Patent Examiner**  
**Art Unit 1624**